

Application No. 10/601,791
Amendment date September 29, 2005
Reply to Office Communication of 06/30/2005

Attorney Docket No. 2359/SPR1.105610

REMARKS

Reconsideration of the present application is respectfully requested. No claims have been added or canceled. Claim 11 has been amended. Claims 1-31 stand rejected and are currently pending.

Rejections based on 35 U.S.C. § 103

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adam et al. (2004/0006726) in view of Acterna Atlas (Remote Fiber Test System).

I. The Office Actions Fails to Make Out a *Prima Facie* Case of Obviousness

The requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

A. *First, there is no suggestion or motivation in the reference (Adam) to modify it or combine its teachings with that of the Acterna reference.*

(i) The prior art does not suggest the desirability of the claimed invention.

The prior art must suggest the desirability of the claimed invention. See MPEP § 2143.01, 1st bold heading. But, at least regarding the “identifying a viewer” recited feature (present in each independent claim), the opposite is true. Adam states that “[p]resenting the data

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as web-compatible files also **eliminates the need for special data viewers.**" See Adam, ¶ [0027] (emphasis added). Accordingly, Adam actually teaches away from the claimed invention. This being the case, there can be no suggestion or motivation to modify Adam.

(ii) The proposed modification of Adam would change the principle operation of it.

The proposed modification cannot change the principle of operation of a reference. See MPEP § 2143.01, 6th bold heading. As mentioned above, Adam states that it would not use data viewers. Accordingly, modifying it ostensibly according to the Acterna manual (which actually does not teach the data-viewer feature) would change its principle of operation. This being the case, there can be no suggestion or motivation to modify Adam.

B. The prior art reference does not teach or suggest all the claim limitations.

The prior art reference must teach or suggest all the claim limitations. See MPEP § 2143.03. The Office Action concedes that Adam does not disclose identifying a viewer that can render the OTDR information in the browser (fourth element of claim 1, and common to all independent claims) but asserts that the Acterna manual discloses a function for identifying a range of privileges of a viewer that can render OTDR information (section Web enabled). See Office Action of 06/30/05, p.2. Below is a quotation of the cited section:

Web enabled

Atlas is accessed via the familiar environment of a standard web browser, so there is no need for additional specialist software or training. Management of maintenance schedules and contracts is straight-forward, with just the right level of information presented in a readily-understandable format.

A series of user-defined codes and passwords ensure the security of the system, with a range of privileges assigned from the server station. Customers of dark fiber providers, for example, may be assigned view-only privileges allowing them to check the status of the network at any time.

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It appears that the above is speaking about individuals that observe data. The Office Action labels the same as "viewers" (note, the word "viewers" is not actually used). The excerpt is talking about assigning privileges to individuals so that they can see certain data at certain times. But Applicant is not referring to human beings in the language of their claim. It would not make sense for human beings to be an entity that "render[s] the OTDR information in the browser." Rather, a viewer, as used by Applicant, refers to a web viewer, such as web viewer 118. *See* FIG. 1A. Accordingly, the above excerpt is inapplicable, as it is speaking of an entirely different thing and offers no teaching or suggestion related to identifying a viewer that can render the OTDR data.

II. Other dependent claims are separately patentable.

For example, consider claims 7-8 and 21. The Office Action asserts a conclusion unsupported by facts that "it would have been obvious to modify Adam with the claimed plug-in to facilitate the measurement." But the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *See* MPEP § 2142, 1st bold heading citing § 2143-2143.03. The Office Action relies on Applicant's own disclosure. But knowledge of Applicant's disclosure must be put aside in reaching an obviousness determination. The Office Action offers no evidence that such would be obvious. But with regard to 103 rejections, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., that the reference teachings establish a *prima facie* case of obviousness) is more probable than not. *See Id.*

The above is equally applicable to the Office Action's assertions that it would have been obvious to store trace files and access them in their native format. But the opposite is true. As Applicant states in paragraph [0006], carriers typically use proprietary databases that

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are populated with OTDR data. Thus, regarding each independent claim (which recites a "native format" feature) as well as various dependent claims (such as 5, 14, 20, and 27), it would not have been obvious to store the OTDR trace file in its native format. The Office Action concedes that Adam does not explicitly disclose receiving the trace file in its native format but then merely concludes that it would be obvious to store the trace file in its native format. *See* Office Action, p.2. In light of Applicant's comments related to the problems associated with storing trace files in their native format for future data presentation (such as in paragraph [0006]), Applicant respectfully requests the Office to reconsider whether it would be obvious to store the trace files in their native format, and to the extent that it believes it would, to provide sufficient evidence to support the proposition.

CONCLUSION

The Office Action fails to make out a *prima facie* case of obviousness at least because there is no suggestion or motivation in Adam to modify it or combine its teachings with that of the Acterna reference and because the prior art reference does not teach or suggest all the claim limitations.

No fee is believed due in connection with this Amendment, but the Commissioner is hereby authorized to charge any additional amount required or to credit any overpayment to Deposit Account No. 21-0765.

Respectfully submitted,



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